

REMARKS

Reconsideration of this application is respectfully requested. Claims 1-10, 14-16, 20, and 31 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,182,183 by Wingard. The remaining claims stand objected to but allowable if re-written.

Claims 1, 5, 7, 9-12, 14, 15, 17-20, 24, 26, 31-32 and 34-35 are amended. New claims 37 and 38 have been added. Applicants have taken this opportunity to amend the claims to improve the technical mechanics of the claims.

IMPROPER RE-OPENING OF THE PROSECUTION OF THIS APPLICATION

First, the applicants traverse the pulling of this case from the appeal's process in light of the Wingard patent. Applicants assert that procedurally that this act was improper and also a clear violation of the purpose of the new changes to the appeal's process. The changes made to the appeal's process according to the comments were in the spirit to reduce the pendency time of patent applications in the patent office rather than as another mechanism to increase the pendency, which is happening in this present application. (See the comments in the Federal Register /Vol. 69 No., 155 page 49963, which is attached to this response). Further, the comments state that pulling the case from appeal to reopen the prosecution of the case that "it is envisioned that new grounds of rejection in the Examiner's answer's would be rare, rather than a routine occurrence." (See the same comments attached to this response). The reason why the comments say that a case may be reopened is because "many

appellants are making new arguments for the first time in their appeal brief."

(See the same comments which is attached to this response).

In this present case, the claims were previously only amended in response to the first office action. The claims remained the same during the response to the second office action, the response to the third office action, and in the filed appeal brief. No new arguments were raised except to respond to concerns initiated by the Examiner and to point out that the references do not disclose the limitations in the claims. The Examiner pulled this case back from the appeal process, conceding the persuasiveness of the arguments in the appeal brief. Note, virtually the same arguments found to be persuasive in the appeal brief can earlier be found in the response to the third office action addressing the same issues. Thus, no new claim amendments occurred and no new arguments were raised in the appeal brief to justify re-opening this case.

Further, a more overtly blatant violation to the above cited passages from the comments on the new appeals process is that the Examiner pulled this case back from the appeal process, conceding the persuasiveness of the arguments in the appeal brief, but re-cites the same prior art from 2 and 1/2 years and 3 office actions ago as "a new ground of rejection" with similar arguments presented three years ago. The reasons why the claims of this application are patentable over the Wingard prior art are the same as they were 2 and 1/2 years ago. Wingard did not disclose the limitations in the claims as written 2 and 1/2 years ago and does not disclose the limitations as currently amended. However, right now applicants address the procedural/logical correctness of reopening of this

case when the PTO is publicly espousing that it is not self-creating these long pendency periods. As discussed, virtually the same arguments found to be persuasive in the appeal brief can earlier be found in the response to the third office action addressing the same issues. As will be discussed below, the arguments pointing out similar deficiencies in the Wingard reference can be found in the earlier response submitted 2 1/2 years ago. The even more troubling fact is that to reopen this case "any new ground of rejection must be personally approved by the Technology center director or designee." Applicants would like an answer as to how this case in light of the same prior art overcome 2 and 1/2 years ago qualifies as a rare instance of re-opening the case under a "new grounds of rejection in the Examiner's answer's." Accordingly, applicants assert that procedurally that the act of pulling this case from the appeals process in light of the Wingard reference was improper and also a clear violation of the purpose of the new changes to the appeal process. Applicants request as a prayer for relief an allowance of the claims of this application on the basis that 1) the Examiner's answer concedes that all the claims overcome the prior art and 2) the re-opening of this case was improper.

Applicants are entitled to a thorough search and examination on the very first office action. Applicants should not have to file three responses, an appeal brief, and a subsequent fourth response on similar but not identical claims to receive a patentability determination based on the *content* disclosures of the prior art. Applicants acknowledge that specific points raised by the Examiner have reversed themselves or pointed to slightly different areas in the Wingard patent;

however, the net result is that Wingard still fails to disclose the same three limitations pointed out in the response to the 10-2-03 office action. Some attention to making re-opening a case a rare instance should have caught these overt points and stopped this increasing of the pendency of this application.

102(E) REJECTION

The office action states that Claims 1-10, 14-16, 20, and 31 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,182,183 by Wingard.

The issue is:

"To anticipate a claim, the reference must teach every limitation of the claim. A claim is anticipated only if each and every limitation as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

(Manual of Patent Examining Procedures (MPEP 2131.)

Applicants respectfully submit independent claim 14, as amended, is not anticipated by Wingard under 35 U.S.C. 102(e). Claim 14, as amended, states:

14. A method for communicating data between functional blocks in a computing device, comprising:
establishing at least one first identifier, each first identifier associating a data transfer with a transaction stream that the data transfer between an initiator functional block and a target functional block are part of;
if the target functional block is unable to accept a first data transfer from the initiator functional block, the target functional block issuing a busy signal identified by the first identifier;
storing in a buffer one or more data transfers received by the target functional block after issuance of the busy signal until resources become available to service the buffered data transfers, the amount of buffer space sufficient to buffer any transfers that arrive after the busy signal is asserted, wherein an interface between the initiator functional block and the target functional block does not block data transfers of other threads; and
mapping a data flow from the initiator functional block to the target functional block to a first transaction stream indicated by its

unique first identifier to meet a service guarantee on a per first identifier basis within a multiple threading system.
(emphasis added)

Applicants agreed with the Examiner that Wingard does not disclose expressly or inherently mapping a data flow from the initiator functional block to the target functional block to a thread indicated by the thread identifier to meet a service guarantee on a per thread identifier basis. (See office action dated 10-2-03 page 7). However, currently Examiner cites Col. 8 lines 39-65, Col. 14 lines 54-67, and Col. 11 lines 45-64 of the Wingard reference as disclosing this limitation. Wingard at Col. 8 lines 37 to 67 talks in general about how ConnIDs allow the system to recognize communications with different quality of service (QOS) guarantees associated with them. (See Wingard at Col. 8 lines 37 to 67) However, nothing in Wingard at Col. 8 lines 37 to 67 discloses *mapping data flows to a transaction stream indicated by its unique identifier* in order to meet QOS on an individual basis. Likewise, Wingard at Col. 14 lines 54-67 merely mentions mapping connIDs to thread IDs with no literal or inherent disclosure of *mapping data flows to transaction streams* indicated by ID in order to meet QOS on an individual thread basis. Likewise, Wingard at Col. 11 lines 45-64 discloses "The target may associate meanings such as transfer priority to the CONNID values, and therefore decide which requests to act upon based upon a combination of the CONNID value and the internal state of the target." However, nothing in Wingard at Col. 8 lines 37 to 67 discloses *mapping data flows a transaction stream indicated by its unique identifier* in order to meet QOS on an individual basis. Accordingly, Wingard at the sections cited by the Examiner

does not disclose "mapping a data flow from the initiator functional block to the target functional block to a first transaction stream indicated by its unique first identifier to meet a service guarantee on a per first identifier basis within a multiple threading system."

Wingard at the sections cited by the Examiner does not disclose expressly or inherently storing in a buffer data transfers received after issuance of the busy signal until resources become available to service the buffered data transfers. However, in direct contrast, Wingard at Col. 10 and the first few lines of Col. 11 states the opposite of this concept in that the target actually blocks, via accepting no other data transfers from threads with the same ID, when a busy signal is issued. Wingard states:

The first bit will be set if the current transfer will receive a BUSY response (due to resource conflict) and no earlier transfer in the queue has the same CONNID and has its first bit set. The first bit implies that the current transfer is the first of a set of potentially-pipelined transfers that will need to be BUSY'd to enforce ordering. The busy bit is set if either the target has a resource conflict or one of the earlier transfers in the queue has the same CONNID and has the first bit set. This logic enforces the REQ-RESP pipeline latency, ensuring that the target accepts no pipelined transfers until the initiator can react to the BUSY response to the transfer marked first.

(Wingard at Col. 10 line 58 to Col. 11 line 2) (Emphasis added)

Accepting no [zero] pipeline transfers after an initial busy signal is issued by a target is not the same as storing in a buffer one or more data transfers received after issuance of the busy signal until resources become available to service the buffered data transfers. Accordingly, Wingard does not disclose "storing in a buffer one or more data transfers received by the target functional block after issuance of the busy signal until resources become available to service the buffered data transfers."

Wingard at Col. 10 cited by the Examiner also does not disclose expressly or inherently the amount of buffer space sufficient to store any transfers that arrive after the busy signal is asserted so that an interface between the initiator functional block and target functional block does not block data transfers of other threads. In contrast, Wingard at Col. 10 regarding the size of this storage buffer states that the size of a queue in the target matches the depth of the latency of the system. (Col. 10 Lines 48-50) Figure 6, which is the overall heading from which this discussion is generally coming from shows system latency to be two system clock cycles between issuance of a request from an initiator and communication of the status of the response to that request. As discussed above in Col 10-11, Wingard discloses having "logic [that] enforces the REQ-RESP pipeline latency, ensuring that the target accepts no pipelined transfers until the initiator can react to the BUSY response." Thus, the target queue in Col. 10 is not sized to account for system latency plus the amount of buffer space sufficient to buffer any transfers that arrive after the busy signal is

asserted. Yet, claim 14, as amended, states *"the amount of buffer space sufficient to buffer any transfers that arrive after the busy signal is asserted."*

Overall, Wingard at the cited sections does not disclose: 1) mapping a data flow from the initiator functional block to the target functional block to a first transaction stream indicated by its unique first identifier to meet a service guarantee on a per first identifier basis; 2) storing in a buffer one or more data transfers received by the target functional block after issuance of the busy signal until resources become available to service the buffered data transfers; and/or the size of the buffer being sufficient to buffer any transfers that arrive after the busy signal is asserted. Wingard does not disclose each and every limitation of claim 14. As such, claim 14, as amended, is not anticipated by Wingard under 35 U.S.C. § 102(e).

Given that claims 15-19 depend from and include the limitations of claim 14, applicants submit that claims 15-19 are not anticipated by Wingard under 35 U.S.C. § 102(e).

Likewise, independent claims 1, 20, and 31 and their respective dependent claims including new claims 37 and 38 contain one or more similar limitations but not identical to those discussed for claim 14. Thus, independent claims 1, 20, and 31 and their respective dependent claims are patentably distinct from Wingard for their own reasons. Note, although the specific points raised by the Examiner have reversed themselves or pointed to slightly different areas in the Wingard patent, the net result is that Wingard still fails to disclose

the same three limitations pointed out in the response to the 10-2-03 office action.

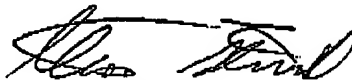
Conclusion

It is respectfully submitted that in view of the amendments and remarks set forth herein, the rejections and objections have been overcome. Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Applicants reserve all rights with respect to the application of the doctrine equivalents. If there are any additional charges, please charge them to our Deposit Account No. 02-2666.

Respectfully submitted,
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Dated: _____

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states that claims 1–15 are grouped together; (ii) Claims being grouped together but argued separately (e.g., claims 1–9 rejected under 35 U.S.C. § 102 over A, the appellant groups claims 1–9 together but then argues the patentability of claims 1 and 5 separately); and (iii) examiners disagreeing with the appellant's grouping of claims.

(10) In paragraph (c)(1)(vii), any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown (requirement found in former Rule 192(a)), and a separate heading is required for each ground of rejection in place of the previous grouping of claims section of the brief. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When an appellant argues as a group multiple claims subject to the same ground of rejection, the Board may select a single claim from that group of claims and treat its disposition of a ground of rejection of that claim as applying to the disposition of that ground of rejection of all claims in the group of claims. Notwithstanding any other provision of this paragraph, an appellant's failure to argue separately claims that the appellant has grouped together constitutes a waiver of any argument that the Board must consider the patentability of any grouped claim separately. See *In re McDaniel*, 293 F.3d 1379, 1384, 63 USPQ2d 1462, 1465–66 (Fed. Cir. 2002) (interpreting former Rule 192(c)(7) to require separate treatment of separately rejected claims). Any claim argued separately should be placed under a subheading identifying the claim by number and claims argued as a group should be placed under a subheading identifying the claims by number. For example, if Claims 1 to 5 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. Y and appellant is only going to argue the limitations of independent claim 1, and thereby group dependent claims 2 to 5 to stand or fall with independent claim 1, then one possible heading as required by this subsection could be *Rejection under 35 U.S.C. 102(b) over U.S. Patent No. Y* and the optional subheading would be Claims 1 to 5. As another example, where claims 1 to 3 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. Z and the appellant wishes to argue separately the patentability of each claim, a possible heading as required by this subsection could be *Rejection under 35 U.S.C. 102(b) over U.S. Patent No. Z*, and the

optional subheadings would be *Claim 1*, *Claim 2*, and *Claim 3*. Under each subheading the appellant would present the argument for patentability of that claim.

(11) Paragraph (c)(1)(vii) states that “Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable”, a statement in slightly different form appeared in former Rule 192(c)(7).

(12) Paragraph (c)(1)(vii) eliminates subparagraphs (i) through (v) of former Rule 192(c)(8) which related to the manner in which arguments were to be made. Although they provided useful advice as to what an effective argument ought to include, these provisions have often been ignored by appellants and, for the most part, have not been enforced as set forth in paragraph (d) of that rule.

(13) Paragraph (c)(1)(ix) is added to require appellant to include an evidence appendix of any evidence relied upon by appellant in the appeal with a statement setting forth where that evidence was entered in the record by the examiner so that the Board will be able to easily reference such evidence during consideration of the appeal.

(14) Paragraph (c)(1)(x) is added to require appellant to include a related proceedings appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section so that the Board can take into consideration such decisions.

(15) Paragraph (c)(2) is added to exclude any new or non-admitted amendment, affidavit or other evidence from being included in the brief.

(16) Paragraph (d) is added to provide that appellants will be notified of reasons for non-compliance and given a period of time to file an amended brief.

(17) Paragraph (e) is added to provide notice that the periods set forth in this section are extendable under the provisions of Rule 136 for patent applications and Rule 550(c) for ex parte reexamination proceedings. This provision appeared in former Rule 191(d).

Section 41.39 is added to generally incorporate requirements found in former Rule 193(a).

Section 41.39(a)(2) is added to permit a new ground of rejection to be included in an examiner's answer eliminating the former prohibition of new grounds of rejection in examiner's answers. Many appellants are making new arguments for the first time in their appeal brief (apparently stimulated by a former change to the appeal process that inserted the prohibition on new grounds

of rejection in the examiner's answer). Because the current appeal rules only allow the examiner to make a new ground by reopening prosecution, some examiners have allowed cases to go forward to the Board without addressing the new arguments. Thus, the revision would improve the quality of examiner's answers and reduce pendency by providing for the inclusion of the new ground of rejection in an examiner's answer without having to reopen prosecution. By permitting examiners to include a new ground of rejection in an examiner's answer, newly presented arguments can now be addressed by a new ground of rejection in the examiner's answer when appropriate. Furthermore, if new arguments can now be addressed by the examiner by incorporating a new ground of rejection in the examiner's answer, the new arguments may be able to be addressed without reopening prosecution and thereby decreasing pendency.

It is envisioned that new grounds of rejection in examiner's answers would be rare, rather than a routine occurrence. The Office plans to issue instructions that will be incorporated into the MPEP requiring that any new ground of rejection made by an examiner in an answer must be personally approved by a Technology Center Director or designee and that any new ground of rejection made in an answer be prominently identified as such. It is the further intent of the Office to provide guidance to examiners that will also be incorporated into the MPEP as to what circumstances, e.g., responding to a new argument or new evidence submitted prior to appeal, would be appropriate for entry of a new ground of rejection in an examiner's answer rather than the reopening of prosecution. Where, for example, a new argument(s) or new evidence cannot be addressed by the examiner based on the information then of record, the examiner may need to reopen prosecution rather than apply a new ground of rejection in an examiner's answer to address the new argument(s) or new evidence.

Paragraph (b) of § 41.39 is added to set forth the responses an appellant may make when an examiner's answer sets forth a new ground of rejection. Appellant is required within two months from the date of the examiner's answer containing a new ground of rejection either:

(1) To request that prosecution be reopened by filing a reply under Rule 111 with or without amendment or submission of affidavits (Rules 130, 131 or 132) or other evidence, which would